

Serial No. 10/659,219
Atty. Doc. No. 2001P17947WOUS

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REMARKS

Applicants have amended claims 6 - 8, 10, 13, 15 and 16. Thus, claims 1, 2 and 4 - 18 are presented for examination. Applicants respectfully request reconsideration and allowance of the pending claims in view of the foregoing amendments and the following remarks.

Response to objections to the Specification:

The Examiner has objected to the disclosure due to informalities. Applicants have amended the specification to overcome the informalities per the Examiners recommendations. Therefore, withdrawal of the objections to the disclosure is respectfully requested.

Response to objections to Claims 10 and 16:

The Examiner has objected to claims 10 and 16. Applicants have amended claims 10 and 16 to overcome the objections per the Examiners recommendations. Therefore withdrawal of the objections to claims 10 and 16 is respectfully requested.

Response to rejections under Section 112 First Paragraph:

Claims 1 - 2 and - 4 - 18 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention at the time the application was filed.

The Examiner has a very difficult burden to make and maintain a 35 U.S.C. § 112, para. 1 rejection. MPEP 2163 provides that "there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed," citing Wertheim, 541 F.2d at 262, 191 USPQ at 96. MPEP 2161.01(III) further provides the Examiner "must establish on the record a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation*," citing *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971).

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Because the Examiner has failed to comply with the requirements of MPEP 2163.04 when making and maintaining the 35 USC 112, para.1 rejection, the rejection must be reversed.
MPEP 2163.04 requires that:

In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion (see MPEP § 2163 for examination guidelines pertaining to the written description requirement). These findings should:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.... When appropriate, suggest amendments to the claims which can be supported by the application's written description, being mindful of the prohibition against the addition of new matter in the claims or description.

The Examiner has not met the requirements of MPEP 2163.04. The Examiner has failed to establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

In Claims 1, 13 and 14 the examiner has indicated that the amendments including "a high energy beam", "melting", "melting and homogenization of ... a region of the substrate directly below the irradiated near-surface region" and "without melting and homogenizing a region of the substrate located laterally adjacent the melted an homogenized substrate region." are new matter. As explained in MPEP 2163(II)(2)&(3), the Examiner has not indicated that she has reviewed the entire application to understand how applicant provides support for the various features of the claimed invention and then determine whether there is sufficient written description to inform a skilled artisan that applicant was in possession of the claimed invention as a whole at the time the application was filed. It is improper for the Examiner to merely recite one selected portion of the disclosure without consideration of the entire disclosure. Since the Examiner has failed to provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the above identified inventive concepts and also has not shown why such skilled artisan would need to resort to undue experimentation

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to make and use the claimed thermal barrier coating repair, the Examiner has failed to meet the requirements of MPEP 2163.04. Withdrawal of the Section 112 first paragraph rejections are respectfully requested.

Response to rejections under Section 112 Second Paragraph:

Claims 6 - 9 and 13 - 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention. Applicants have amended claims 6 - 9 and 13 - 15 to overcome the examiners rejections. Withdrawal of the Section 112 second paragraph rejections are respectfully requested.

In light of the applicants amendments and remarks, the applicants respectfully submit that the claims are in condition for allowance.

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Conclusion

For the foregoing reasons, it is respectfully submitted that the objections and rejections set forth in the Final Office Action are inapplicable to the present claims. Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: 2/5/07

By: John P. Musone
John P. Musone
Registration No. 44,961
(407) 736-6449

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830